

#Frn T. Lanham  
8-4-98



I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail addressed to:

Assistant Commissioner for Patents  
Washington, D. C. 20231

on:

7/20/98  
Date

Elaine Zahn  
Elaine Zahn

ATTORNEY DOCKET NO. DS/91068

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

\_\_\_\_\_  
In re: James B. Williams, Jr. et al.  
\_\_\_\_\_

RECEIVED  
98 JUL 24 PM 2:38  
GROUP 180

Application No.: 07/715,258

Filed: 6/14/91

Title: ICON FOR COMPUTER DISPLAY

Examiner: M. Tung

Group Art Unit: 2911

APPELLANT'S BRIEF ON APPEAL

**TABLE OF CONTENTS**

TABLE OF CASES .....	3
1. REAL PARTY OF INTEREST .....	4
2. RELATED APPEALS AND INTERFERENCES .....	4
3. STATUS OF CLAIMS .....	4
4. STATUS OF AMENDMENTS .....	4
5. SUMMARY OF INVENTION .....	6
6. ISSUES .....	6
7. GROUPING OF CLAIMS .....	6
8. ARGUMENT .....	6
9. APPENDIX .....	14

**TABLE OF CASES**

*Ex Parte Strijland*, 26 USPQ 1d 1259 (BOPA. 1992) ..... 7, 9  
*In re Zahn*, 204 USPQ 988, 994-996 (CCPA 1980) ..... 10, 11  
*In re Hruby*, 153 USPQ 61 (1967) ..... 11

**1. REAL PARTY OF INTEREST:**

The real party of interest is Xerox Corporation.

**2. RELATED APPEALS AND INTERFERENCES:**

The related Appeals or Interferences are as follows:

Patent Application Serial No. 07/342,516

Patent Application Serial No. 07/342,517

Patent Application Serial No. 07/343,181

Patent Application Serial No. 07/343,182

Patent Application Serial No. 07/715,144

Patent Application Serial No. 07/715,145

Patent Application Serial No. 07/715,257

Patent Application Serial No. 07/715,259

Patent Application Serial No. 07/715,260

Patent Application Serial No. 07/715,261

Patent Application Serial No. 07/715,262

Patent Application Serial No. 07/715,263

Patent Application Serial No. 07/715,840

**3. STATUS OF CLAIM:**

The Claim is rejected.

**4. STATUS OF AMENDMENTS:**

An Office Action of February 25, 1993 rejected the claim as non-statutory subject matter under 35 U.S.C § 171. Appellants' Amendment of May 21, 1993, based on support in the application as a whole, added a representative "computer display" to the drawing. This addition was, by way of a final Office Action of June 4, 1993, deemed as introducing new matter under 35 U.S.C. § 132, 37 CFR § 1.118 and as failing to comply with the

description requirement of 35 U.S.C. § 112 - the rejection based on 35 U.S.C § 171 was repeated and made final.

Prosecution of the present Application was suspended pending the outcome of an appeal of a similar design application, U.S. Serial No. 07/715,145. Following a two plus year delay, the Examiner withdrew the Final Office Action in the present and suspended case following the release of published guidelines on icon design patent applications (see 1185 OG 60.)

In an Office Action of September 16, 1996, Appellants were required to elect from one of three groups of inventions under 35 U.S.C. § 121. In response to such restriction, Appellants, by way of an Amendment of October 15, 1996, elected to continue prosecution of the first inventive group.

In an Office Action of February 4, 1997, the Title of the Invention was objected to under the second paragraph of 35 U.S.C. § 112 as being indefinite for use of the term "OR THE LIKE". Additionally, the assertion regarding addition of new matter was repeated and the claim was rejected under 35 U.S.C § 171 as failing to show a computer-generated icon embodied in an article of manufacture. In an Amendment of May 5, 1997, Appellants sought to amend the claim of the Invention to further clarify the relationship of the computer-generated icon to the computer display.

An Office Action of August 5, 1997, objected to the Title of the Invention and further required cancellation of the Figures of Groups II and III from the Drawing. Moreover, the rejection regarding new matter was reasserted along with the rejection under 35 U.S.C. § 171. In an Amendment of November 4, 1997, Appellants amended the specification to overcome any pending objections and provided remarks indicating a manner in which addition of a computer display to the drawing is supported by the application as a whole. Additionally, evidence was provided to substantiate that it was known, at the time of filing of the present application, to use icons in conjunction with computer displays.

An Office Action of February 18, 1998 finally rejected the claim while providing detailed remarks directed toward the issue of "whether or not there is support in the original title, specification, and drawing to support the specific configuration of the broken line disclosure in the amendment submitted 4/24/93."

**5. SUMMARY OF INVENTION:**

Appellants' invention is directed to an "ICON FOR COMPUTER DISPLAY". Figs. 1-3 show a detailed view of the Icon; the broken lines showing the representative computer display are for illustrative purposes only and form no part of the claimed design. The present invention is used to implement computer functions by selecting the Icon shown on the computer display.

**6. ISSUES:**

a. Whether Appellants' Amendment of May 21, 1993 introduces new matter under 35 U.S.C. § 132 and 37 C.F.R. § 1.118, while failing to comply with the description requirement of the first paragraph of 35 U.S.C. § 112.

b. Whether the claim is directed to non-statutory matter under 35 U.S.C. § 171.

**7. GROUPING OF THE CLAIMS:**

The single claim of the present Application is to be considered on appeal.

**8. ARGUMENT:**

a. Appellants' addition of the originally disclosed computer display to the drawing does not constitute new matter and the application does not fail to comply with the description requirement of the first paragraph of 35 U.S.C. § 112.

Appellants filed the present design patent application on June 14, 1991. In the first Office Action, dated February 25, 1993, it was stated that "[t]he claim is rejected as non-statutory subject matter under 35 U.S.C. 171 as it is not directed to an article of manufacture." The Office Action concluded that "[t]he design as claimed and shown in the drawing disclosure is merely a

picture or surface ornamentation rather than a design applied to an article." Additionally, the Office Action concluded "any supplemental disclosure of an article to which the design might be applied would be new matter under 35 U.S.C. 132 and 37 C.F.R. 1.118."

Appellants' originally filed application designates in the title that they had "invented a new, original, and ornamental design for a PAPER TRAY ICON FOR A COMPUTER DISPLAY OR THE LIKE". Appellants' originally filed application also specifies in the claim that the Paper Tray Icon is "for a computer display" (i.e. the article of manufacture in which the Paper Tray Icon is embodied). The Application further states that the drawing forms a part of the specification, and sets forth that each Figure is a "front view" of Appellants' "new design for a PAPER TRAY ICON FOR A COMPUTER DISPLAY OR THE LIKE." As such, Appellants clearly disclosed the article in the original disclosure so as to permit one of ordinary skill in the pertinent area of design to identify it as a "computer display."

In accordance with the holding *Ex Parte Strijland*, 26 USPQ 2d 1259 (BOPA. 1992) (indicating that a claim to a computer-generated icons would be patentable provided the corresponding application and drawing indicated that the icon is embodied in the computer article and the computer article was shown in broken line drawing), Appellants submitted drawing amendments showing the computer display in phantom or "broken" lines. Essentially, Appellants' amendment sought simply to clarify the invention and insure uniformity between the specification and drawing. The added broken lines of the "computer display" in the drawing are clearly and firmly based on Appellants' multiple originally filed references to the "computer display" as the relevant article, as detailed above. Additionally, Appellants' Amendment of May 5, 1997 emphasizes that the broken lines shown in Figures 1-3 are for illustrative purposes only and form no part of the claimed design.

Despite the original disclosure of the "computer display" as the relevant article of manufacture, the amended drawing provided in Appellants' amendment has been deemed to introduce new matter, and the claim has been rejected for failing to comply with the description requirement of the first paragraph of 35 U.S.C. § 112. Declaring the "rectangular display screen in broken lines" to be new matter in paragraph 2 of the final Office Action of June 4, 1993, the Examiner stated: "It is noted that the words 'computer

display' appear in the title[; h]owever, these words, which are relatively vague as no actual structures, such as [a] screen or panel, are identified, are not held to be sufficient support for the addition of a computer display screen, whether claimed or not, to the actual drawing disclosure." The Examiner cites 37 C.F.R. § 1.118 and 35 U.S.C. § 132 as a basis for determining that the representative computer display now shown in the drawing is new matter, and 35 U.S.C. § 112, first paragraph, in asserting that the disclosure requirement has not been met.

Appellants submit that there is little confusion regarding the meaning of the term "computer display" since such term is well understood by both those skilled in the art of computer-generated icon design as well as laypersons. Referring to Appendix I, the respective dictionary definitions of "computer" and "display" are consistent with the view that a computer display is an article for displaying information, such as computer generated icons.

Additionally, in view of the patent literature available at the time of the filing of the present application, one of skill in the art of computer generated icon design would understand readily the manner in which the present Icon is embodied in the article. In performing an on-line database search for the present application, several references relating to the use of graphic icons on video screens (each having a date predating the filing date of the present application) were found.

Finally, it is submitted that the U.S. Patent and Trademark Office understood that icons are embodied in computer displays since the present application was classified in a design area (D18) relating to "office machinery" and "printing devices". By its own actions, relative to the prosecution of the present application, the USPTO has demonstrated a tacit understanding that the Icon of the present application is embodied in the screen of a computer.

The Office Actions received thus far virtually ignore references in the present application to the "computer display" article and thus view amendment of the drawing to be impermissible. This is in contradiction to the rules governing such matters. 37 C.F.R. § 1.118(a) specifies in pertinent part that "[a]ll amendments to the specification, including the claims, and the drawings filed after the filing date of the application must conform to at least one of them as it was at the time of the filing of the application." Appellants' amended drawing, in now conforming to the title, description *and* claim, clearly



meets this requirement, which applies to design applications according to 37 C.F.R. § 1.151. Only “[m]atter *not found in either*, involving a *departure from* or an *addition to* the original disclosure, cannot be added to the application . . . .” 37 C.F.R. § 1.118(a) (emphasis added). No showing has been made or grounds established to support a determination that the representative computer screen now in the drawing in any way “departs from” or “adds to” the disclosure of that article in the original title, specification and claim of the application. As such, the drawing amendment in the present application is properly distinguished from an application having a symbol, feature or element in (or added to) an original drawing that is not disclosed in the original application.

Appellants’ amended drawing adds no new matter and is proper according to other pertinent rules governing design patent applications, namely 37 C. F. R. § 1.117. Section 117 sets forth that,

[t]he specification, claims and drawings must be amended and revised when required, to correct inaccuracies of description and definition or unnecessary prolixity, and to secure correspondence between the claims, the specification and the drawing.

The present application discloses the article in the title, specification and claims; as such, the plain meaning of 37 C. F. R. § 1.117 also permits the drawings to be amended in the conforming manner presented by Appellants.

In view of the above discussion, it is clear that both the meaning of the term “computer display” is well known and that computer-generated icons are employed with computer displays. Nonetheless, the Office Action of February 18, 1998 asserts that mere “understanding [of] the meaning of a word does not necessarily describe its visual characteristics” and a “computer display is not a ‘conventional feature,’ . . . in the design sense.” As will appear, this view of amending a drawing in a design patent application having a claim directed toward a computer-generated icon is, in at least two respects, inconsistent with the prevailing standards of the U.S. Patent and Trademark Office (USPTO).

First, both Section 2 of the USPTO Guidelines at 1185 OG 60 and *Ex Parte Strijland* (at 1263) dictate that the article of manufacture, in a drawing

for a computer-generated icon is to be shown in terms of broken lines. Moreover, the MPEP § 1503.02 provides:

A broken line showing is for illustrative purposes only and forms no part of the claimed invention. . . . The use of broken lines indicates that the environmental structure or the portion of the article depicted in broken lines forms no part of the design, and is not to indicate the relative importance of parts of the design.

Hence, USPTO standards contemplate that, in a drawing for a computer-generated icon, the computer display is to serve as a conventional feature which is merely representative an exemplary computer display article. That is, the computer display article is intended to clarify the environment in which the novel icon design resides and is not intended to be limited to a screen of any particular shape or size. The icon could be large relative to the screen or small relative to the screen without altering the applied design of the icon. The Paper Tray Icon design is the invention of the present application, not any particular shape or structure of a known computer display with which the icon is displayed.

The Examiner details an argument in support of the final rejection suggesting that that addition of a computer display in broken line drawing would require support in the form of a size description for the computer display in the original application. (See Analogy, at Section 5. of the final Office Action of February 18, 1998 to the sizes of a car that might be an article of manufacture in another situation). Appellants are unaware of any such requirement to define the size of an article in broken line drawing, and submit that they are not required to limit the scope of their claim to an icon on a particular size of screen, or to an icon of a particular size on that screen.

To give weight to the broken lines in the manner suggested by the Office Action of February 18, 1998 would raise broken lines to a level of significance that is not supported by the controlling law, *In re Zahn*, 204 USPQ 988, 994-996 (CCPA 1980). More particularly, as taught by *Zahn*, the broken lines are only intended to indicate the existence of the article, but not *how* the subject design is embodied in the article:

No sound authority has been cited for any limitation on *how* a design is to be embodied in an article of manufacture. Here the design is embodied in the shank portion of a drill and a drill is unquestionably an article of manufacture. It is thus applied design as distinguished from abstract design. . . . We note also that § 171 refers, not to the design *of* an article, but to a design *for* an article, and is inclusive of ornamental designs of *all* kinds including surface ornamentation as well as configuration of goods.

*Zahn* at 995 (emphasis in original) (*citing, In re Hruby*, 153 USPQ 61 (1967)).

It follows from *Zahn* that, in the case of an applied design, the exact dimensions or characteristic features of an article of manufacture shown in broken line drawing are irrelevant. That is, the broken line drawing of the article is intended to convey nothing more than the mere presence of the article. There can be little doubt, in view of the opinions of *Zahn* and *Hruby*, that an article, when provided in broken line drawing, is to be treated as environment or background. Accordingly, the design in *Zahn* is for a drill bit shank, and *not* any particular drill (i.e. article). If the case were otherwise, an applicant would be forced to disclose an unlimited number of design/article configurations in order to obtain comprehensive coverage for an applied design, e.g. a separate design application would be required for a range of shank/drill or icon/screen configurations.

Second, in view of the circumstances surrounding the present application, the above-mentioned Guidelines at 1185 OG 60 mandate that the Examiner permit amendment of the drawing as proposed by the Appellants. In particular, while the Office Action of February 18, 1998 indicates that the computer display referred to in the specification as filed is neither adequately described nor conventional, it implicitly admits that the application is at least directed toward an icon embodied on a computer display. (See Section 6 of the Office Action) Indeed it would difficult to dispute that the disclosure as a whole does not at least “*suggest* the claimed subject matter as a computer-generated icon embodied in a computer screen, monitor, [or] other display panel.” (See USPTO Guidelines at Section 2(b) Additionally, it should be noted that the

Guidelines only require that a relationship between the computer article be suggested and that the computer article can assume one of several forms (namely a computer screen, monitor or other display panel). It is submitted that unless the Examiner can show a failure on Appellants' part to suggest a relationship between an icon and a computer display, she is obligated under the Guidelines, at Section 2(b), to "[s]uggest amendments which would bring the claim into compliance with section 171."

**b. The claim is directed to statutory matter under 35 U.S.C. 171, as the icon for the computer display as described and claimed is shown and used on a computer display.**


The claim of the present application has been rejected under 35 U.S.C. § 171 as not being directed toward statutory subject matter. The USPTO Guidelines at 1185 OG 60 provide that a design for computer-generated icon is patentable provided:

- 1) the computer screen, monitor, other display panel, or portion thereof is shown in broken or solid lines with the icon displayed on it, and
- 2) the claim is directed to the subject matter as embodied in an article of manufacture.

On the basis of support in the original title, specification and claim, the drawing has been amended to show the "Paper Tray Icon" surrounded by a broken line representative of a computer display or screen. Moreover, on the basis the original title, specification and claim, it should now be clear that the Icon is embodied in the computer display, i.e. the Icon is used to provide

ornamentation for the computer display. Hence the Icon of the subject application constitutes patentable subject matter in accordance with the requirements of both 35 U.S.C. § 171 and the pertinent USPTO Guidelines.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Gary B. Cohen", is written over a horizontal line.

Gary B. Cohen  
Attorney for Appellants  
Registration No. 33,127

GBC/ez  
July 20, 1998

Xerox Corporation  
Xerox Square 20A  
Rochester, New York 14644  
Telephone: 716-423-6612

9. **APPENDIX A:**

**CLAIM APPEALED:**

The following is the appealed claim:

The ornamental design for an Icon for a Computer Display as shown and described.

10. **APPENDIX B:**

**EXHIBIT SUBMITTED DURING PROSECUTION OF THE  
PRESENT APPLICATION, ATTACHED AS FOLLOWS:**

(l) *Webster's Ninth New Collegiate Dictionary*, Merriam-Webster, Inc. 1990, at 271 and 365

## 271

[illegible]

**Available C**  
**: SHIPMENT**

**display** *n.* often attrib (1665) 1 *a.* (1): a setting or presentation of something in open view (a fireworks ~) (2): a clear sign or evidence: EXHIBITION (a ~ of courage) 2 *n.* ostentatious show 3 *v.* type, com-

ʌ about ʌ kitten. F table ɜr further ʌ ash ʌ ace ʌ cot. cart  
 ʌ out ʌ chin ɛ bet ɛ easy ɜ go ʌ hit ʌ ice ʌ job  
 ɜ sing ɔ go ɔ law ɔi boy ʌ thin ʌ the ʌ foot ʌ foot  
 ʌ yet ʌ vision ʌ. k. ʌ. æ. ʌ. u. ʌ. ʌ see Guide to Pronunciation





### A GENUINE MERRIAM-WEBSTER

The name *Webster* alone is no guarantee of excellence. It is used by a number of publishers and may serve mainly to mislead an unwary buyer.

A *Merriam-Webster*® is the registered trademark you should look for when you consider the purchase of dictionaries or other fine reference books. It carries the reputation of a company that has been publishing since 1831 and is your assurance of quality and authority.

Copyright © 1990 by Merriam-Webster Inc.

Philippines Copyright 1990 by Merriam-Webster Inc.

Library of Congress Cataloging in Publication Data  
Main entry under title:

Webster's ninth new collegiate dictionary.

p. cm.

ISBN 0-87779-508-8. — ISBN 0-87779-509-6 (indexed). — ISBN  
0-87779-510-X (deluxe)

1. English language—Dictionaries.

PE1628.W5638 1990

423—dc20

89-38961

CIP

Abbr

Webster's Ninth New Collegiate Dictionary principal copyright 1983

COLLEGIATE trademark Reg. U.S. Pat. Off.

All rights reserved. No part of this book covered by the copyrights hereon may be reproduced or copied in any form or by any means—graphic, electronic, or mechanical, including photocopying, taping, or information storage and retrieval systems—without written permission of the publisher.

Made in the United States of America

3637383940RMcN90